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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,919	12/21/2000	Thomas R. Bayerl	Sprint 1501 (4000-02700)	6827

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EXAMINER	
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ART UNIT	PAPER NUMBER
2111	5

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/745,919	BAYERL ET AL.	
	Examiner	Art Unit	
	Khanh Dang	2111	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 November 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-7, 9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by McClear et al.

At the outset, it is noted that similar claims will be grouped together to avoid repetition in explanation.

As broadly drafted, these claims do not define any structure/step that differs from McClear et al. With regard to claims 5 and 11, McClear et al. discloses an apparatus for preventing contention on a data bus connecting a central processing unit and a peripheral device when the central processing unit calls for a read operation followed by a write operation, comprising: a transceiver (83, for example) with bus hold circuitry (see at least Fig. 3) and an output enable input (see at least Fig. 2 and discussion provided below) connected between the data bus input/output connections of the central processing unit and the peripheral (a typical PCI bus of McClear et al.), and control logic (174/ASIC 85, for example) having an input for receiving a CPU chip select signal and an output for providing a peripheral control signal which ends at a preselected time (predetermined time) before the end of the read operation (see at

least Fig. 2 and description thereof), the control logic output connected to a control input of the peripheral and to the output enable input of the transceiver (see at least Figs. 2 and 3, and description thereof). With regard to claim 6, McClear et al. discloses a buffer (shown generally at 0-N Fig. 5; see also Fig. 3, particularly) connected between an address output of said central processing unit and an address input of said peripheral device, said buffer having an output enable input connected to a chip select signal. With regard to claim 7, the preselected time (predetermined time) is equal to or greater than the maximum time to enable high impedance state of said transceiver. In another word, active output will remain for a predetermined time period before returning to a tri-state or high impedance state. With regard to claims 1-3, and 9, it is clear that one using the apparatus of McClear et al. would have performed the same step set forth in claims 1-3, and 9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClear et al.

McClear et al., as explained above, discloses the claimed invention including the preselected time (predetermined time period). However, McClear et al. does not specifically disclose that the preselected time (predetermined time period) is greater than 50 nanoseconds. It would have been obvious to one of ordinary skill in the art at the time the invention was made to set the preselected time greater than 50 nanoseconds for the predetermined time of McClear et al., since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges (greater than 50 nanoseconds) involves only routine skill in the art. *In re Aller*, 105 USPQ 233. It has also been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F2d 272, 205 USPQ 215 (CCPA 1980).

Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClear et al.

McClear et al., as explained above, discloses the claimed invention. However, McClear et al. does not specifically disclose various clock cycles for Read and for ending Read. It would have been obvious to one of ordinary skill in the art at the time the invention was made to set an appropriate clock cycles for the system of McClear et al., since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

Applicants' arguments filed 11/21/2003 have been fully considered but they are not persuasive.

At the outset, Applicants are reminded that claims subject to examination will be given their broadest reasonable interpretation consistent with the specification. *In re Morris, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997).* In fact, the "examiner has the duty of police claim language by giving it the broadest reasonable interpretation." *Springs Window Fashions LP v. Novo Industries, L.P.,* 65 USPQ2d 1862, 1830, (Fed. Cir. 2003). Applicants are also reminded that claimed subject matter not the specification, is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).

With this in mind, the discussion will focus on how the terms and relationships thereof in the claims are met by the reference(s). Response to any limitations that are not in the claims or any arguments that are irrelevant and/or do not relate to any specific claim language will not be warranted.

The McClear et al. Rejection:

With regard to claims 1 (with claims 2-4 stand or fall together), claim 5 (with claim6-8 stand or fall together), claim 9 (with claim 10 stand or fall together), and claim

1 (with claim 12 stand or fall together), Applicants argued that in McClear, "it is not possible for the control logic 174 to have an input for receiving a chip select signal from the CPU or an output for providing a peripheral control signal." Contrary to Applicants' argument, it is from at least Fig. 2 (transceiver circuit) and Fig. 5 (transceiver) of McClear et al., the incoming signal from the CPU passes through 171, 173, and 174 of the transceiver. In another word, the control logic 174 does have an input for receiving signal from the CPU. Applicants also argued that in McClear, "it is not possible for the control logic to be connected to a control input of the peripheral and to the output enable input of the transceiver." Contrary to Applicants' argument, it is clear from at least Fig. 2 (transceiver circuit) and Fig. 5 (transceiver) of McClear et al., that the transceiver (Fig. 5) is connected to a control input of a peripheral downstream of the transceiver. Therefore, it is clear that control logic 174 (Fig. 2) is connected to the control input of the peripheral downstream of the transceiver. It is also clear from at least Fig. 2, and description thereof of McClear that the control logic 174 is connected to the output enable input of the transceiver. The control logic 174 provides output enable control line for driver 176, for example, which provides an output enable input for the transceiver (the line connecting 176 to A).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Khanh Dang at telephone number 703-308-0211.

Khanh Dang
Primary Examiner